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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,939	11/21/2003	Billy Gayle Moon	P08568-US2	3519
24239	7590	10/04/2005	EXAMINER	
MOORE & VAN ALLEN PLLC P.O. BOX 13706 Research Triangle Park, NC 27709			LAO, SUE X	
			ART UNIT	PAPER NUMBER
			2194	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,939

Applicant(s)

MOON ET AL.

Examiner

Sue Lao

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 37-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 37-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/21/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-19 and 37-54 are pending. This action is in response to the preliminary amendment filed 11/23/2003. Applicant has amended claims 1-19 and 37-54 and canceled claims 20-36 and 55-67.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 1-19 and 37-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of independent claims 1 and 37 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Independent claims 1 and 37 do not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention comprised of software alone. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or

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mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998). MPEP 2106. State Street required transformation of data by a machine before it applied the "useful, concrete, and tangible test." However, State Street does not hold that a "useful, concrete and tangible result" alone, without a machine, is sufficient for statutory subject matter. State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

Claims 1-19 and 37-54 are rejected under 35 U.S.C. 101 because the claimed invention appears to be comprised of software alone without claiming associated computer hardware required for execution.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach the claimed limitations "a plurality of application wrappers that run independently of said operating system" as recited in claims 1-19 and 37-54.

In the application as filed, there does not appear to be any detailed descriptions or disclosure of application wrappers that run independently of the operating system.

While applicant states that "[a]n application wrapper is a program that runs independently of a computer's operating system 18" on page 5, lines 10-12, which is the only recitation of an application wrapper running independently of the operating system, applicant in fact discloses, throughout the disclosure, that the application wrapper

depends on the operating system to function. For example, applicant discloses that the application wrapper communicates with the operating system so as to create icons with graphic capabilities beyond those allowed by the operating system (see page 4, lines 11-16); application wrappers communicate with the computer's operating system (see page 5, lines 29-30); application wrappers are loaded after loading of the operating system is completed (see page 6, lines 5-6); icon representing an application wrapper is created within a program manager of the computer system (see page 6, lines 20-29) [It is noted that a program manager is a typical component of an operating system such as Windows operating systems]; application wrappers communicate with other software applications via the operating system (see page 10, lines 19-29). In other words, the application wrappers as disclosed depend on the operating system for communicating with other components of the computer system (hardware/software resources, other applications), for timing of initiation, for timing of loading and for hosting location, to the least. At best, applicant discloses that the application wrapper extends the graphic capabilities of the underlying operating system.

It is well known in the art that any application running on a computer system uses computer resources such as the CPU, memory and I/O devices, which are controlled by the operating system. Operations, such as generating and displaying an icon and receiving user selection/click of the icon displayed, typically require using computer resources such as CPU, memory and I/O devices. Applicant fails to disclose how such operations are performed, nor how the extended capabilities are provided, independent of the operating system.

Applicant fails, in the specification as filed, to disclose in any detail that the application wrappers of the present application run independently of the operating system.

Claims 1-19 and 37-54 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant recites "a plurality of application wrappers that run independently of said operating system" in claims 1-19 and 37-54. There does not appear to be an adequate written description of the claimed limitation in the application as filed, for the reasons set forth in the objection to the specification.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 2, 7-11, 15-19, 37, 38, 43-46, 50-54 are rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,678,744. Although the conflicting claims are not identical, they are not patentably distinct from each other. For example, the present claims 1 and 37 are met by U.S. Patent No. 6,678,744, claim 1, lines 1-19 and claim 6, lines 4-5. The present claims 2, 38 are met by U.S. Patent No. 6,678,744, claim 2. The present claims 7-9, 43-45 are met by U.S. Patent No. 6,678,744, claims 4-6. As to claims 10, 11, 15-19, 46, 50-54, these are met by U.S. Patent No. 6,678,744, claims 3, 8 and the help file and configuration/setting file are typical modules of an application

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and thus would have been obvious to be modularly accessed in the manner recited in claims 3-6 of U.S. Patent No. 6,678,744.

Claims 3-6, 12-14, 39-42, 47-49 are rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,678,744 in view of Alfredsson (U S Pat. 5,457,798). As to claims 3-6, 12-14, 39-42, 47-49, Alfredsson teaches managing an application's start up at power up and communicating with the application via an application wrapper (col. 2, line 55 – col. 3, line 42). Therefore, it would have been obvious to manage an applications' start up and communication via application wrappers.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-19 and 37-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "the operation, execution, performance, security, functions" in line 13. There is insufficient antecedent basis for this limitation in the claim. For the purpose of art rejection, it is interpreted as "operation, execution, performance, security, functions", as best understood and as it appears to be.

Claims 2, 5, 6, 14 recite "the computer system" in line 3. There is insufficient antecedent basis for this limitation in these claims. For the purpose of art rejection, it is interpreted as "the computing device", as best understood and as it appears to be.

Regarding claims 37, 38, 41, 42 and 49, note the rejections/remarks of the corresponding claims 1, 2, 5, 6 and 14 above.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Lao whose telephone number is (571) 272-3764. A voice mail service is also available at this number. The examiner's supervisor, SPE Meng-Ai An, can be reached on (571) 272 3756. The examiner can normally be reached on Monday - Friday, from 9AM to 5PM. The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 27, 2005

  
**SUE LAO**  
**PRIMARY EXAMINER**